

ESTTA Tracking number: **ESTTA858562**

Filing date: **11/15/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Robert Diggs		
Entity	Individual	Citizenship	UNITED STATES
Address	c/o Peter Paterno, Esq., King, Holmes 1900 Avenue of the Stars, 25th Floor Los Angeles, CA 90067 UNITED STATES		

Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 4 Times Square, 17th Floor New York, NY 10036 UNITED STATES Email: jweinberger@fzlz.com, jinsley-pruitt@fzlz.com Phone: (212) 813-5900
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Applicant Information

Application No	87480295	Publication date	10/17/2017
Opposition Filing Date	11/15/2017	Opposition Period Ends	11/16/2017
Applicant	Woof-Tang Clan, LLC #2K 105 Lincoln Rd Brooklyn, NY 11225 UNITED STATES		

Goods/Services Affected by Opposition


Class 045. First Use: 2016/12/02 First Use In Commerce: 2017/01/17 All goods and services in the class are opposed, namely: Dog walking services; Pet sitting
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Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3578668	Application Date	11/21/2007
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Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	WU-TANG CLAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1993/01/15 First Use In Commerce: 1993/01/15 Compact discs featuring music; DVDs featuring music; Digital media, namely, [pre-recorded video cassettes,] digital video discs, [digital versatile discs,] downloadable audio and video recordings,DVDs, [and high definition digital disks] featuring music; Pre-recorded CDs, [video tapes, laser disks and] DVDs featuring music; Audio and video recordingsfeaturing music; Audio recordings featuring music; [Digital audio tape recorders;] Downloadable MP3 files, MP3 recordings [, online discussion boards, webcasts and podcasts] featuring music [, audio books and news broadcasts]; Downloadable musical sound recordings; Downloadable video recordings featuring music; Musical sound recordings; Musical video recordings; Pre-recorded digital media featuring music; Pre-recorded electronic media music</p> <p>Class 025. First use: First Use: 1993/01/15 First Use In Commerce: 1993/01/15 Infant and toddler one piece clothing; [Short sets;] Shirts; Short-sleeved orlong-sleeved t-shirts; Sweat shirts; [Denims;] Jogging pants; Sweat pants; Headgear, namely, hats and caps; [Shoes; Sneakers;] Sweat shorts; Tank tops; Tops; Coats; Jackets</p> <p>Class 041. First use: First Use: 1993/01/15 First Use In Commerce: 1993/01/15 Entertainment,namely, live performancesby a musical band; Entertainment, namely, live music concerts; [Music composition for others; Production of sound and music video recordings;] Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials</p>		

U.S. Registration No.	3578670	Application Date	11/21/2007
Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	WU-TANG		

Design Mark	
Description of Mark	The mark consists of a highly stylized version of the letter "W" resembling a bat with the words "Wu-Tang" in the middle.
Goods/Services	<p>Class 009. First use: First Use: 1993/01/15 First Use In Commerce: 1993/01/15 Compact discs featuring music; DVDs featuring music; Digital media, namely, [pre-recorded video cassettes,] digital video discs, [digital versatile discs,] downloadable audio [and video] recordings, DVDs, [and high definition digital disks] featuring music; Pre-recorded CDs, [video tapes, laser disks and] DVDs featuring music; Audio and video recordings featuring music; Audio recordings featuring music; Downloadable MP3 files, MP3 recordings, [online discussion boards, webcasts and podcasts] featuring music [, audio books and news broadcasts]; Downloadable musical sound recordings; [Downloadable ring tones, graphics and music via a global computer network and wireless devices]; [Downloadable video recordings featuring music;] Musical sound recordings; Musical video recordings; Pre-recorded digital media featuring music; Pre-recorded electronic media music</p> <p>Class 025. First use: First Use: 1993/01/15 First Use In Commerce: 1993/01/15 Tops; Infant and toddler one piece clothing; [Short sets;] Shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; [Denims;] Jogging pants; Pants; Sweat pants; Headgear, namely, hats and caps; [Shoes; Sneakers;] Sweat shorts; Tank tops; Coats; Jackets</p> <p>Class 041. First use: First Use: 1993/01/15 First Use In Commerce: 1993/01/15 Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; [Production of sound and music video recordings;] Entertainment namely, live performances by a musical band; Entertainment, namely, live music concerts; [Music composition for others]</p>

Attachments	77335201#TMSN.png(bytes) 77335438#TMSN.png(bytes) F2424074.pdf(28210 bytes)
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Signature	/s/ James D. Weinberger
Name	James D. Weinberger
Date	11/15/2017

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ROBERT DIGGS,

Opposer,

-against-

WOOF-TANG CLAN, LLC,

Applicant.

NOTICE OF OPPOSITION

Opposer, Robert Diggs, an individual with an address of c/o Peter Paterno, Esq., King, Holmes, 1900 Avenue of the Stars, 25th Floor, Los Angeles, California 90067 believes that he would be damaged by the issuance of a registration for the trademark WOOF-TANG CLAN, as applied for in Application Serial No. 87/480,295, and therefore opposes the same. As grounds for the opposition, Opposer, by his attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is a renowned musician and record producer who is known professionally by the name RZA.
2. Since at least as early as 1993, Opposer has been a leader of the famous hip-hop group WU-TANG CLAN. The group has been active through recordings and live performances for more than twenty years, and musical recordings and merchandise bearing the WU-TANG CLAN mark and related marks (collectively, the “WU-TANG CLAN Mark”) enjoy massive sales.
3. Opposer is the owner of all right, title, and interest in and to the WU-TANG CLAN Mark, as used in connection with a wide variety of goods and services. As a result of

Opposer's use and promotion of the WU-TANG CLAN Mark, the WU-TANG CLAN Mark has come to be recognized as identifying goods and services of Opposer exclusively and has come to represent enormous goodwill of Opposer.

4. In light of the duration and wide-spread nature of Opposer's association with the WU-TANG CLAN Mark, the WU-TANG CLAN Mark is unmistakably associated with Opposer such that it constitutes part of his identity.

5. In addition to his common law rights, Opposer owns several federal registrations for the WU-TANG CLAN Mark, including, but not limited to:

- U.S. Reg. No. 3,578,668 for the mark WU-TANG CLAN in connection with "Compact discs featuring music; DVDs featuring music; Digital media, namely, digital video discs, downloadable audio and video recordings, DVDs, featuring music; Pre-recorded CDs, DVDs featuring music; Audio and video recordings featuring music; Audio recordings featuring music; Downloadable MP3 files, MP3 recordings featuring music; Downloadable musical sound recordings; Downloadable video recordings featuring music; Musical sound recordings; Musical video recordings; Pre-recorded digital media featuring music; Pre-recorded electronic media music" in International Class 9, "Infant and toddler one piece clothing; Shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; Jogging pants; Sweat pants; Headgear, namely, hats and caps; Sweat shorts; Tank tops; Tops; Coats; Jackets" in International Class 25, and "Entertainment, namely, live performances by a musical band; Entertainment, namely, live music concerts; Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials" in International Class 41; and
- U.S. Reg. No. 3,578,670 for the mark WU-TANG & Design in connection with "Compact discs featuring music; DVDs featuring music; Digital media, namely, digital video discs, downloadable audio recordings, DVDs, featuring music; Pre-recorded CDs, DVDs featuring music; Audio and video recordings featuring music; Audio recordings featuring music; Downloadable MP3 files, MP3 recordings, featuring music; Downloadable musical sound recordings; Musical sound recordings; Musical video recordings; Pre-recorded digital media featuring music; Pre-recorded electronic media music" in International Class 9, "Tops; Infant and toddler one piece clothing; Shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; Jogging pants; Pants; Sweat pants; Headgear, namely, hats and caps; Sweat shorts; Tank tops; Coats; Jackets" in International Class 25, and "Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other

multimedia materials; Entertainment namely, live performances by a musical band; Entertainment, namely, live music concerts” in International Class 41,

both registered on February 24, 2009 and based on first use in commerce on January 15, 1993.

6. The above registrations are valid, subsisting, and in full effect and serve as prima facie evidence of the validity of the marks and of Opposer’s exclusive right to use the WU-TANG CLAN Mark in connection with the goods identified therein, pursuant to Section 33(a) of the Lanham Act, 15 U.S.C. § 1115(a).

7. Upon information and belief, the owner of the application at issue is Woof-Tang Clan, LLC (“Applicant”), a New York limited liability company with an address of 105 Lincoln Road, #2K, Brooklyn, New York 11225.

8. On June 8, 2017, Applicant filed Application Serial No. 87/480,295 (the “Application”) to register the mark WOOF-TANG CLAN (“Applicant’s Mark”) in connection with “Dog walking services; Pet sitting” in International Class 45, based on first use on December 2, 2016 and first use in commerce on January 17, 2017.

9. On information and belief, Applicant had actual knowledge of Opposer’s prior rights to and interest in the WU-TANG CLAN Mark before seeking to register Applicant’s Mark.

FIRST CLAIM FOR RELIEF UNDER SECTION 2(a)
(FALSE SUGGESTION WITH PERSONS, LIVING OR DEAD)

10. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 9 as if fully set forth herein.

11. Applicant’s Mark falsely suggests a connection with persons, living or dead, namely, Opposer, who has long been associated with the group WU-TANG CLAN.

12. Registration of Applicant’s Mark in connection with the services set forth in the Application therefore violates Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

13. By reason of the foregoing, Opposer is likely to be harmed by registration of Applicant's Mark.

SECOND CLAIM FOR RELIEF
UNDER SECTION 2(d) (LIKELIHOOD OF CONFUSION)

14. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 13 as if fully set forth herein.

15. Opposer's WU-TANG CLAN Mark has been used continuously by Opposer since a date prior to any date on which Applicant can rely. As such, Opposer's rights in the WU-TANG CLAN Mark are prior and superior to any rights Applicant may claim in Applicant's Mark.

16. Applicant's Mark is highly similar to Opposer's WU-TANG CLAN Mark in sight, sound, and commercial impression.

17. Applicant seeks to register Applicant's Mark for services that consumers are likely to believe come from the same source as goods and services sold by Opposer under the WU-TANG CLAN Mark.

18. As a result of the similarity of the marks and the goods and services, Applicant's use and registration of Applicant's Mark in connection with the services identified in the Application are likely to cause confusion, cause mistake, or to deceive consumers to falsely believe that Applicant's services emanate from or otherwise are authorized, sponsored by, or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

19. By reason of the foregoing, Opposer is likely to be harmed by registration of Applicant's Mark.

THIRD CLAIM FOR RELIEF UNDER SECTION 43(c) (DILUTION)

20. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 19 as if fully set forth herein

21. Opposer's WU-TANG CLAN Mark is a famous mark, and became so prior to the earliest date upon which Applicant can rely.

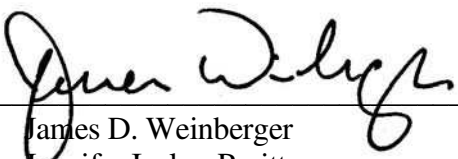
22. Applicant's use and registration of Applicant's Mark will damage Opposer by trading on the enormous goodwill associated with the famous WU-TANG CLAN Mark, and thus diminishing the goodwill that Opposer has built up in his WU-TANG CLAN Mark and diluting its distinctiveness. As such, Applicant's use and registration of Applicant's Mark in connection with the services identified in the Application are likely to cause dilution by blurring of Opposer's famous WU-TANG CLAN Mark, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

23. By reason of the foregoing, Opposer will be harmed by registration of Applicant's Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 87/480,295 be denied.

Dated: November 15, 2017
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Jennifer Insley-Pruitt

4 Times Square
New York, New York 10036
Tel.: (212) 813-5900
Email: jweinberger@fzlz.com
jinsley-pruitt@fzlz.com

Attorneys for Opposer